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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,988	04/14/2000	Jeffrey M. Chasen	Realnet : 056A	8258

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EXAMINER
BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
2615	

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/549,988	Chasen
Examiner	**Art Unit**
Boccio, Vincent	2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 10, 2002* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-24 and 27-34* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-24 and 27-34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

Claim Objections

1. Claims 12, 15 and 18 etc., objected to because of the following informalities:

Claims 12, 15 and 18, etc., recite, "ROM DRIVE", the examiner requires removal of the "ROM", because applicant is performing recording.

Although the examiner prior and now, clearly understood and interpreted, that "the CD ROM drive", is merely associated with "the spinning/rotation of the media such as optical etc.", and is considered to be no different than the spinning means to spin the well known, CD E/CD RW or even other media.

The drive means associated with "a CD ROM disc" in "a CD ROM player", is considered to be substantially the same, as the drive means associated with "a re-writable type media and drive", such as "CD E/CD RW even DVD", or other, besides that the, Re-writable media and drive **provide for a head for writing to the media**, in addition to the READ head provided in the CD ROM DRIVE, other than that known to be substantially the same as drive means, as those skilled in the art clearly understand.

Since the examiner believes that the recited "ROM", only provides potential to clutter and confuse the issues, **the examiner requires that the ROM language be removed from all claims, since ROM provides the potential for confusion to those viewing the claims,**

"in view of applicants recited CD ROM DRIVE means can perform recording".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-11, 13-14, 19-24, 27, 29-30, 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomason et al.(US 6,018,612).

Regarding claims 1-2, 6-8, 13, 19-24, 32-33, Thomason in Fig. 1, meets the limitations associated with a method and associated apparatus for recording and playing data, the apparatus and associated method comprising the steps performed on the elements as recited comprising:

o a first and second devices(col. 4, line 35-, hard disk 36 and buffer memory 35);

o a record and play modules("elements 33 and 12-14" & "elements 2-4, 31") which are configured to record on the second device, a first stream representing a first set of data from the first device; and also configured to play a second stream representing a second set of data

from the second device wherein the play module plays the second stream while the record module records the first stream.

The system is configured to receive TV signals thru tuner 1, , therefore video and audio, wherein data is received by element 2, from the tuner and stored, while earlier data received and

stored data, can be controlled by user interface 26, reproduced and output at element 12.

Regarding claims 3-5 and 9-11, Thomason all meets the limitations of audio, video or multimedia, since TV signals are received with audio and video.

Regarding claim 14, Thomason all meets the limitations wherein the first and seconds devices, could be the same device box, or element, first-second devices(met by the combination of 35 and 36, as like the record and play modules, may comprise multiple elements inside the unit or device).

Regarding claims 27 and 29, since Thomason discloses the microprocessor controlled, with programming in the Rom 22 and parameters or variables in RAM 23, as disclosed col 3., "software", etc., the limitation as recited computer readable medium comprising instruction for performing the simultaneous recording of data and the reproduction of data from the system is considered met in view thereof.

Regarding claim 30, Thomason further meets the limitation of having audio, wherein the audio is encoded and recorded therefore, the audio is stored in at least one encoding format, inherently(see "3").

Regarding the claims as amended wherein recording takes less time, than reproduction of the same, met in view of a single head for recording & reproduction, further slow reproduction.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 12, 16-18, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason et al.(US 6,018,612), as applied above.

Regarding claim 12, Thomason meets the limitation of a first device, and discloses the utilization of a hard disk, but fails to disclose the utilization of a CD ROM type drive.

The examiner takes official notice that CD ROM type recording devices are well known and widely used and available type devices, therefore, it would have been obvious to one skilled in the art at the time of the invention to Thomason by substituting a CD ROM type device, the substitution being considered an obvious design choice to choose between widely used and available recording devices, to perform the same as the hard disk used by Thomason.

Regarding claims 16-18, Thomason as applied above meets all limitations as recited but fails to disclose encryption of the input data such as audio encryption of received audio data.

The examiner takes official notice, that audio encryption is well known and obvious technique to protect audio material,

therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Thomason as applied by incorporating encryption of input audio in order to protect audio works as is well known.

Regarding claims 28, Thomason as applied discloses receiving TV signals, which have audio and video, but, fails to disclose wherein the data is in a packet or packetized form from a remotely disclosed computer network.

The examiner takes official notice that receiving data signals in packet form is well known over the Internet etc., therefore, it would have been obvious to one skilled in the art at the time of the invention to utilize or even substitute a source from the Internet to receive data in packets, being a mere design choice of a source well known and obvious to one skilled in the art.

6. Claims 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason et al.(US 6,018,612), as applied above and further in view of Suzuki et al.(US 6,438,315).

Regarding claims 31 and 34, since Thomason fails to provide details associated with encoding, decoding audio data in a system which records TV signals from a tuner therefore A/V, converts to digital(2) and compresses the data(3), records in a digital

format, but, fails to provide details associated with the audio format and "wherein the audio format or encoding format is automatically detected for playing", interpreted as parameters such as identification of audio encoding format(encoding format of audio, bit rate and/or compression standard), although, the examiner realizes in a digital environment this feature of auto detection of audio format or even video, the sensing of the format for proper decoding can be considered to be an inherent feature, associated with a system that can reproduce different audio, video formats associated with digital recording, or to clearly show recording audio in a plurality of formats.

Suzuki teaches recording and reproduction of various CD types and data recording formats handled by one device for at least the audio data(col. 13, lines 15-62, Fig. 4, Fig. 1, CD I, VCD, Karaoke CD, Fig. 2, "Moving, still and audio", also see Fig. 3, wherein Figs. 9-24 B, show various encoding parameters etc....., wherein at after a CD is inserted Fig. 4, and the play button is pushed, the automatic detection of audio as well as video formats would be automatically detected and properly decoded by the player automatically detecting the management information upon playing and suppling the recorded data from the CD (disc), to the proper decoding sections, (see input of format information, Fig. 26, "13 and 14", provided with "Information of Source", for at least audio, also see Fig. 27, 28, 29, and

reproduction in Fig. 30, as taught by Suzuki.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Thomason by providing management data for digitally recorded material, audio, video etc., and to automatically detect and properly decode the data, upon a user requesting reproduction as taught by Suzuki, as is well known and conventional, providing ease of use by allowing the user to insert and select desired media, wherein the user is not required to define the format for reproduction, but, to merely request play of the disc inserted, wherein the system can detect and select proper decoding elements, as is conventional and well known to those skilled in the art.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason et al.(US 6,018,612), as applied to claim 12, above, in view of Toshinori(EP 07249271, dated 9/1995).

Regarding claim 15, Thomason as applied to claim 12, fails to disclose performing tests on the CD ROM or the first device.

Toshinori teaches a system for performing a record test on a CD rom device, to evaluate the CD rom drive, as taught by Toshinori.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Thomason by

incorporating at least one test to evaluate the CD Rom device or disk memory device used, as taught by Toshinori.

Response to Arguments

8. Applicant's arguments filed 12/10/02 have been fully considered but they are not persuasive.

{A} In re page 7-, 9-, applicant states "There is no suggestion or hint as to how such signals may be recorded in less time than it takes to play them", patentable over Thomason.

In response the examiner fails to agree, that the recited language in the claims 1 etc..., is somehow patentable over Thomason or any other combination, as applied.

Since, there is one head provided, recording to the HARD drive of Thomason is clearly greater in data rate and takes less time to record, with respect to the incoming real time rate from the tuner or encoder.

In addition, the system can provide slower than real time output, when receiving real time input,

therefore, the recording can be faster or take less time, wherein the system can provide real time, or even slower output or longer in time presentation of recorded data than it took the system to write to the hard disk recording device used, basically also reads on slow motion, during simultaneously recording and reproduction of incoming signal time staggered.

Furthermore, the scope of the limitation can also be read on even if two heads or RAM or other types of memory devices are used in the process of simultaneous recording and reproduction operations with audio, video, or any type of multimedia data, the limitation of:

"recording in less time, than it takes to play them", is also met by controlling the reproduction of the reproduced signals in slow mo, slow play, while receiving real time data which is a higher rate.

In addition, by providing information at higher rates, than real time video for example at 30 frames/second, and/or with audio, present recording devices are notoriously well known that can perform, higher than real time recording speeds, for audio and video, as is proven herein in Thomason and other one headed recording devices performing simultaneous R & R.

If applicant fails to agree, please provide a detailed explanation, of how a device can record real time video-audio signal from a tuner, to a hard disk drive with one head, and alternatively reproduce the signal to a user, at real time and even at higher rates than real time, like Fast Forward (1 X + Y) for example, "with one head for recording and reproduction", see col. 4 etc.....?????????????

{B} In re pages 7-9, applicant states, in summary, since a hard

drive has been utilized in Thomason, and since the examiner has taken official notice, determined to the examiner, to be obvious, to utilize a CD ROM DRIVE, since, no reference has been provided in the rejection, applicant is challenging the examiner to support the position, motivation, viability, and further that this position has been arrived thru impermissible hindsight, by using applicant's claims as a "BLUE PRINT", to pick and choose teachings of the prior art to piece together applicant's invention and further states; and further states,

"The examiner has provided no evidence that one of ordinary skill in the art would somehow know that a CD ROM type device would be able **to cope with the dual task**".

In response, after a careful consideration of all stated arguments, the examiner cites Pijnenburg, to support the official notice taken(claims 6 and 12 etc....),

wherein the reference teaches utilization of a CD-E disk compact disk erasable", the system, as in Thomason(HARD DISK), performs simultaneous R/R of data, with a single head(col. 2, lines 55-56), wherein it is clear to the examiner that,

Pijnenburg teaches the viability that a CD-E type optical disk media, can be used and cope with the task of allowing the system to R/R simultaneously, wherein the limitation of CD ROM Drive is considered to be inherently, associated with a CD disc/disk, and is considered to be clearly met.

The examiner believes this issue should be covered, but, to emphasis the examiners position, applicant claims a CD Rom type drive, considered to be the mechanism or system "such as a motor", to spin the media or responsible for rotation and at least reading, a CD type media in the drive, wherein the difference between the HARD DISK and CD E or CD ROM type drives, is basically the media type and type of R/R heads used, one being magnetic recording carrier and heads and the other optical recording carrier and heads, as is well known.

Since applicant makes an issue of this the examiner has objected to all claim language associated with the recited ROM, as being improper to recite and should be amended to CD drive associated with CD media which is for Recording and Reproducing, the reason is that ROM, stands for READ Only Memory and applicant is performing recording.

Since, Pijnenburg teaches utilization of a single head CD drive, with CD-E media, since Pijnenburg records and reproduces to and from a CD-E disk, provides no mention of a CD Rom type drive, because the use of the word ROM, which only provides confusion to those is less understanding, when viewing the claims.

The CD E disk and drive, is considered to be substantially the same conventional drive mechanisms, which can be called, "a CD ROM DRIVE", being used in association with a CD E type

disk, as one skilled in the art would clearly understand.

The CD E and associated drive the examiner believes has supported all issues associated with the modification, viability etc., etc.....

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

10. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin
February 23, 2003

VINCENT BOCCIO
PRIMARY EXAMINER